

## **REMARKS/ARGUMENTS**

This application has been carefully reviewed in view of the Office Action dated October 3, 2005 ("the '05 Office Action"). The '05 Office Action came after reopening of prosecution of the application after the application was withdrawn from issuance following payment of the issue fee on a Notice of Allowance. The application was withdrawn from issue "due to newly discovered references" raised in the '05 Office Action.

The '05 Office Action rejects: claims 1, 3, 5 and 9 under 35 USC 102(b) as being anticipated by Green et al. (U.S. Patent No. 3,830,434); claims 2-4 under 35 USC 130(a) as being unpatentable over Green et al. (U.S. Patent No. 3,830,434) in view of Hough (U.S. Patent No. 5,918,814); and claims 6 -7 under 35 USC 130(a) as being unpatentable over Green et al. (U.S. Patent No. 3,830,434) in view of Colo'n (U.S. Patent No. 6,209,803).

The primary reference, Green (U.S. Patent No. 3,830,434), is not a newly discovered reference. In addition, neither Hough nor Colo'n are new references. Each of the cited references were previously considered by the prior examining attorney. The Green and Hough references were cited by the prior examining attorney in an office action dated November 2, 2004 and such citation was countered by the Applicant, resulting in the notice of allowance. The Colo'n reference was considered by the prior examining attorney but not cited as indicated by the initials of the prior examining attorney on the Applicant's information disclosure statement. Nonetheless, Applicant responds to the '05 Office Action as follows.

### **The Rejection of Claims 1, 3, 5 and 9 under 35 USC 102(b)**

For a prior art reference to anticipate in terms of 35 USC § 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 USPQ 2d 1566 (Fed. Cir. 1990). There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field

of the invention. *Scripps Clinic and Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 18 USPQ 2d 1896 (Fed. Cir. 1991).

The Green reference fails to disclose all of the limitations of independent claim 1. Independent claim 1 has as limitations the following:

“a lip extending horizontally away from the wall along an upper perimeter thereof for supporting the shield adjacent a sprinkler head without attachment thereto; and a notch located substantially near a lower perimeter of the sloping wall and configured to accommodate movement of the sprinkler head relative to the plate”. (emphasis added)

Both of these limitations require that the shield not be attached to the sprinkler head and that the sprinkler head move relative to (or independent of) the shield. Neither of these limitations are taught by Green. Green discusses various placements of the sprinkler head relative to ground level, but does not discuss movement of the sprinkler head during operation. Regardless, Green specifically teaches:

“a central opening 33 may be snapped into the annular groove 12 so that its under surface rests on the surface of the ground with the prongs 32 inserted therein to cover the conical cut-out 30 in the earth, allow unobstructed access to the hexagon body portion of the sprinkler head. This type of installation prevents accidental lateral movement and damage to the sprinkler head.” (col. 4, lines 33-38)  
(emphasis added)

Such teachings clearly show that the shield of Green is secured to the sprinkler to prevent movement of the sprinkler with respect to the shield. In contrast, the shield in independent claim 1 is not attached to the sprinkler head and is specifically designed to permit movement of the sprinkler head relative to the plate. Claims 3, 5, and 9 each depend from claim 1 and each share the same limitations of independent claim 1.

Indeed, if the teachings of Green were applied to the instant application, then the stated purpose of the instant application would be frustrated. Specifically, if the shield of the instant application, being secured to the ground, were attached to the sprinkler head, then the shield itself would prevent the sprinkler head from popping up. The stated purpose of the shield in the instant application is to prevent vegetation from growing over the sprinkler head and interfering with the sprinkler head popping up.

**The Rejection of Claims 2-4 under 35 USC 103(a)**

To establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. M.P.E.P. § 2143.03; citing *In re Royka*, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson* 165 USPQ 494, 496 (CCPA 1970).

Pursuant to the '05 Office Action, the rejection of claim 1 under 35 USC 102(b) as being anticipated by Green "serves as the basis" for the rejection of claims 2-4 under 35 USC 103(a). Claims 2-4 depend from independent claim 1 and as discussed above, the Green reference fails to teach all of the claim limitations set forth in independent claim 1.

Specifically, Green does not teach non-attachment of the shield to the sprinkler head and movement of the sprinkler head relative to the shield. The combination of Green with Hough does not teach these limitations. Hough does not teach non-attachment of the shield to the sprinkler head and movement of the sprinkler head relative to the shield. Hough only teaches that the hole in the protector is sized to allow a sprinkler head to protrude. (col. 3, lines 48-49) The invention claimed in claims 2-4 is further distinguished from Hough in that the sloping wall of the shield is generally concave. Hough teaches a shield with a convex shape. The added limitations of claims 2-4 further distinguish these claims over the cited art.

**The Rejection of Claims 6 and 7 under 35 USC 103(a)**

As with the prior rejection, pursuant to the '05 Office Action, the rejection of claim 1 under 35 USC 102(b) as being anticipated by Green

"serves as the basis" for the rejection of claims 6 and 7 under 35 USC 103(a). Claims 6 depends from independent claim 1 and claim 7 depends from claim 6 and, as discussed above, the Green reference fails to teach all of the claim limitations set forth in independent claim 1. Specifically, Green does not teach non-attachment of the shield to the sprinkler head and movement of the sprinkler head relative to the shield. The invention claimed in claims 6 and 7 is further distinguished from Colo'n in that the sloping wall of the shield is generally concave. Colo'n teaches a shield with a convex shape. The added limitations of claims 6 and 7 further distinguish these claims over the cited art.

Accordingly, independent claim 1, and each of its dependent claims 2-7 and 9 are in condition for allowance, notice of which is respectfully requested.

Respectfully submitted,

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